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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/073,095	02/08/2002	Pascal Pons	8707.2137	3696

7590

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EXAMINER

MULLEN, KRISTEN DROESCH

ART UNIT	PAPER NUMBER
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3762

DATE MAILED: 10/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/073,095

Applicant(s)

PONS ET AL. 

Examiner

Kristen Mullen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5/30/02 (IDS).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-8 and 10-13 is/are rejected.
- 7) ☐ Claim(s) 4, 9 and 10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/8/02, 5/30/02</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claim 9 is objected to because of the following informalities: "connects" in line 7 should be changed to ---connected to---. Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 11-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 11-13 each recite the limitation "the second stimulation stage" in line 2. There is insufficient antecedent basis for this limitation in the claim.

The examiner suggests amending claims 11-13 to be dependent on claim 10.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-2, and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Andersson et al. (5,846,264).

Regarding claim 1, Andersson et al. shows an IMD comprising at least a first stimulation stage including an output capacitor (C1), a stimulation terminal, a charging circuit, a first switch (S1), means for performing a capture test (5), means for adjusting the stimulation voltage, and means for delivering a backup-stimulation and being further characterized in that the means for delivering a backup-stimulation comprises: an additional capacitor (C3) and a second switch (S2) (Fig. 1).

With respect to claim 2, Andersson et al. shows the additional capacitor further comprises a specific capacitor (C3), distinct from said output capacitor (C1) (Fig. 1).

Regarding claim 8, Andersson et al. Shows the additional capacitor further comprises an additional capacitor, and the second switch further comprises means for connecting in series the output capacitor and the additional capacitor during a delivery of backup-stimulation (Col. 3, lines 34-45).

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6. Claims 1-3, and 5-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Russie et al. (6,615,089).

Regarding claim 1, Russie et al. shows an IMD comprising at least a first stimulation stage (22, 32, 42), including an output capacitor (126), a stimulation terminal (23b, 33b, 42b), a charging circuit (Fig. 2), a first switch (122), means for performing a capture test (50, 51), means for adjusting the stimulation voltage, and means for delivering a backup-stimulation and being further characterized in that the means for delivering a backup-stimulation comprises: an additional capacitor (126) and a second switch (122) (Col. 3, lines 34-55; Col. 5, line 31-Col. 6, line 1; Col. 6, lines 26-41).

With respect to claim 2, Russie et al. shows the additional capacitor further comprises a specific capacitor (126 of one of pacing channels 22, 32, 42), distinct from said output capacitor (126 of one of pacing channels 22, 32, and 42) (Col. 6, lines 26-41).

Regarding claim 3, Russie further shows a second stimulation stage (22, 32, 42) having a second output capacitor (126) and a second stimulation terminal (23b, 33b, 42b).

With respect to Claim 5, Russie et al shows the first stimulation stage is one of an atrial stage (42) and a right ventricular stage (22, 32) and said second stimulation stage is the other of the atrial stage and the right ventricular stage (Col. 3, line 66-Col. 4, line 20; Col. 6, lines 26-41).

Regarding Claim 6, Russie et al. shows the first stimulation stage is one of an atrial stage (42) and a left ventricular stage (22, 32) and said second stimulation stage is the other of the atrial stage and the left ventricular stage (Col. 3, line 66-Col. 4, line 20; Col. 6, lines 26-41).

With respect to Claim 7, Russie et al. shows the first stimulation stage is one of a right ventricular stage (22, 32) and a left ventricular stage (22, 32), and the second stimulation stage is

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the other of the right ventricular stage and the left ventricular stage (Col. 3, line 66-Col. 4, line 20; Col. 6, lines 26-41).

Allowable Subject Matter

7. Claims 4, and 10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. Claim 9 would be allowable if rewritten to overcome the minor informality objection set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

9. Claims 11-13 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

With respect to claim 4, the prior art of record fails to teach or suggest an IMD comprising at least a first stimulation stage including an output capacitor, a stimulation terminal, a charging circuit, a first switch, means for performing a capture test, means for adjusting the stimulation voltage, and means for delivering a backup-stimulation and being further characterized in that the means for delivering a backup-stimulation comprises: a second stimulation stage having a second output capacitor distinct from the output capacitor, and a second stimulation terminal all in combination with the first switch connecting the second output capacitor in series with the output capacitor.

Regarding claim 9, the prior art of record fails to teach or suggest an IMD comprising at least a first stimulation stage including an output capacitor, a stimulation terminal, a charging

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circuit, a first switch, means for performing a capture test, means for adjusting the stimulation voltage, and means for delivering a backup-stimulation and being further characterized in that the means for delivering a backup-stimulation comprises: an additional capacitor comprising an additional capacitor and a second switch which comprises means for connecting in series the output capacitor and the additional capacitor, all in combination with the charging circuit having a first output and a second output, the output capacitor having a first plate connected to the first output of the charging circuit and to said first switch connected selectively to the stimulation terminal, the output capacitor having a second plate connected to a third switch connected selectively to a ground potential, the additional capacitor having a first plate connected to the second output of the charging circuit and to a fourth switch connected selectively to a second stimulation terminal, and a fifth switch selectively connected to the output capacitor second plate and the additional capacitor first plate.

With respect to claims 10-13, the prior art of record fails to teach or suggest an IMD comprising at least a first stimulation stage including an output capacitor, a stimulation terminal, a charging circuit, a first switch, means for performing a capture test, means for adjusting the stimulation voltage, and means for delivering a backup-stimulation and being further characterized in that the means for delivering a backup-stimulation comprises: an additional capacitor comprising an additional capacitor and a second switch which comprises means for connecting in series the output capacitor and the additional capacitor, all in combination with the device comprising a second stimulation stage distinct from the first stimulation stage, and comprising the additional capacitor and a second stimulation terminal.

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Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Prutchi et al. (5,735,880) shows two pulse generators, each with output capacitors and output terminals. Lindegren (6,238,419) shows a pulse generator and a back-up pulse generator. Fishler (6,456,877) shows a defibrillator with multiple electrodes, switches and output capacitors. Weijand et al. (5,948,004) shows a pulse generator with a single output terminal but multiple switches and output capacitors. Fishell (4,096,866) shows a pulse generator and a back-up pulse generator. Pless et al. (5,111,816) shows an atrial pulse generator with multiple output capacitors and a ventricular pulse generator with multiple output capacitors.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kristen Mullen whose telephone number is 703-605-1185. The examiner can normally be reached on 10:30 am-6:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on 703-308-5181. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

kdm

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